

IV. AMENDMENTS TO THE DRAWINGS

--- Replacement and annotated mark-up drawing sheets for amended figures showing the amended figures, if any, are attached at the Appendix hereto. Each figure is in compliance with 37 C.F.R. § 1.84. An explanation of the changes, if any, is set forth below in this “Amendments to the Drawings” section. Replacement drawing sheets are identified in the top margin as “Replacement Sheet.” Any replacement drawing sheet including amended figures includes all of the figures appearing on the immediate prior version of the sheet. Any annotated drawing sheets, if the same are required by the Examiner, are identified in the top margin as “Annotated Marked-Up Drawings.” Any deleted figure is noted by an instruction to delete the figure. Any corresponding amendment to the specification necessary to be made because of an amendment to the drawings in this section is made in the corresponding “Amendments to Specification” section.

- THE DRAWINGS OF THE PATENT IS HEREBY AMENDED AS SET FORTH BELOW:

- *No Amendment Made to the Drawings*
- *Attachments: None*

V. REMARKS/ARGUMENTS

- STATUS OF THE CLAIMS

Claims 1 – 24 remain pending in this application. Claims 1, 4, 6, 14, 16, 22 and 23 are currently amended. Claims 2 and 3 have been cancelled. Claims 5, 7 – 13, 15, 17 – 21, and 24 are as in the original.

- OBJECTIONS

- OBJECTIONS TO CLAIMS

- Examiner's Position

The Examiner has raised no objections.

- Applicants' Response

N/A

- REJECTIONS

- REJECTION UNDER 35 U.S.C. §112, Second Paragraph

The Examiner has rejected claims 4, 6, 9 and 23 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention (paragraph 2 of the Office Action). The Examiner notes that in claim 4, R₆, R₇, R₈, and R₉ should be alkyl groups, and argues that the acronyms in claims 6, 9 and 23 are inappropriate.

- Applicants' Response

Applicants respectfully traverse the rejection of claims 6, 9 and 23 based in part on the argument that one of ordinary skill in the art would understand the acronyms set forth therein. However, Applicant has amended the claims to include the chemical nomenclature which would be associated by one of ordinary skill in the art with the acronyms utilized.

Applicants have attached at Exhibit A documents confirming that such acronyms are associated with such nomenclature.

In respect to the Examiner's rejection of claim 4, Applicants extend their appreciation to the Examiner for pointing out an obvious error both in the claims and in the specification. Applicant notes that such terminology is clearly shown to be a ministerial error in that a propyl and hexyl moiety is recited in the specification as being a preferred moiety for R₆, R₇, R₈, and R₉, and therefore "alkylamino" is incorrect. Applicants have amended claim 4 to correct this error.

- REJECTION UNDER 35 U.S.C. §102(b)

- Examiner's Position

The Examiner has rejected several claim groups under 35 U.S.C. §102(b): claims 2 and 3 (paragraphs 5 and 7 of the Office Action), claims 4 and 6 (paragraph 8 of the Office Action), claims 4, 6, 8, 9, and 22 – 24 (paragraph 10 of the Office Action), claims 4, 6 and 8 (paragraph 19 of the Office Action). Incongruously, he also rejections some of the same claim groups (i.e., claim group 4, 6, 8, 9 and 22 – 24) under 34 U.S.C. §103(a) reciting the same reference for both "fully anticipating" as well as making obvious the embodiments of the invention asserted in the claims (see, paragraph 11 of the Office Action).

The Examiner has rejected claim group 2 and 3 under 35 U.S.C. §102(b) as being fully anticipated by the Mellish *et al.* article, Photochemistry and Photobiology 2002, 75(4): 392- 397, and the Abstract 28th Annual American Society for Photobiology Meeting 2000 7(1-6) San Francisco, CA. (paragraph 5 and 7 of the Office Action). The Examiner has further rejected under 35 U.S.C. §102(b) claim group 4 and 6 as being fully anticipated by the Yamada *et al.* 63-187154 reference (paragraph 8 of the Office Action). The Examiner has further rejected claim group 4, 6, 8, 9 and 22 – 24 under 35 U.S.C. §102(b) based on the Karasawa *et al.* JP 55-079441 reference (paragraph 10 of the Office Action). The claim group comprising claims 4, 6, and 8 are rejected under 35 U.S.C. §102(b) as being fully anticipated by the Blinka *et al.* '047 reference.

- Applicants' Response

Applicants herein address each of the Examiner's 102(b) rejections in respect to each claim groups as set forth in the Examiner's Office Action.

- Claims 2 and 3 in Respect of the Mellish *et al.* references (Paragraph 5 and 7 of the Office Action)

Applicants respectfully traverse the Examiner's rejections with respect to the Mellish *et al.* references based in part on the references failing to teach each element of the claimed embodiment. However, Applicants cancellation of claims 2 and 3 herein are asserted to obviate such rejections.

- Claim 4 and 6 in Respect of the Yamada *et al.* 63-187154 Reference (Paragraph 8 of the Office Action)

Applicants respectfully traverse the rejections of claims 4 and 6 as being unpatentable of the Yamada *et al.* 63-187154 reference based in part on the argument that each element of the claim embodiments is not found in the prior art of reference.

Applicants' remarks are now directed to amended claim 4 from which dependent claim 6 depends. Claim 4 indicates a composition on an optical recording medium comprising a optical state security material and an electron transfer agent of a defined quantity selectively positioned with respect to the optical state change material change, as set forth in the amended claim. Respectfully, the Yamada *et al.* 63-187154 reference does not teach such composition in any manner, particularly as applied to an optical recording medium. As such the reference can not be said to be anticipatory.

- Claims 4, 6, 8, 9 and 22 - 24 in Respect of the Karasawa *et al.* JP 55-079441 Reference (Paragraph 10 of the Office Action)

Applicants respectfully traverse the rejections of claims 4, 6, 8, 9 and 22 – 24 based in part on the argument that each element of the claim embodiments is not found in the prior art of reference.

Applicants' remarks are now directed to amended claim 4 and 22 and depending claims 6, 8, 9 and 23, 24 respectively. Applicants first note that the Examiner does not demonstrate that the Karasawa *et al.* JP 55-079441 indicates application of the compositions

disclosed therein to an optical disc, as set forth in amended claims 4 and 22 of the composition discussed therein. Secondly, the Karasawa *et al.* JP 55-079441 reference requires R₆, R₇, R₈, and R₉ are either hydrogen or methyl.

The structure of amended claim 4 specifically does not provide for R₆, R₇, R₈, and R₉ to be H, and specifically does not allow each of R₆, R₇, R₈, and R₉ to be methyl (i.e., methylene blue) (note paragraph 00058 wherein it is specifically noted that methylene blue does not provide the absorption characteristics desired). Therefore, the Karasawa *et al.* JP 55-079441 reference does not only not anticipate claim 4 (and therefore claims 6, 8 and 9), but actually teaches away from these embodiments.

Claim 22 requires that the dye be activatable by a wavelength of between about 630 nm to about 660 nm on the optical disc when in an optical disc coating. As stated at paragraph 00015 of the specification, it was unexpected to the inventors that a lambda shift may occur when dye substances are placed into the coating of an optical medium. Given the difficulties involved in identifying such shift, and the fact that methylene blue was found not to be useful at such wavelength, the compounds in the Karasawa *et al.* JP 55-079441 reference (which again the Examiner has not demonstrated to relate to the application of such materials to an optical disc) do not teach, suggest or imply the embodiments asserted in claim 22, or claims 23 or 24 that depend therefrom.

- Claims 4, 6, and 8 in Respect of the Blinka *et al.* '047 Reference (Paragraph 19 of the Office Action)

Applicants respectfully traverse the rejections of claims 4, 6, and 8 with respect to the Blinka *et al.* '047 reference based in part on the argument that each element of the claim embodiments is not found in the prior art of reference.

Applicant remarks are now directed to amended claim 4 from which dependent claims 6 and 8 depend. Claim 4 indicates a composition on an optical recording medium comprising a optical state security material and an electron transfer agent of a defined quantity selectively positioned with respect to the optical state change material, as set forth in the amended claim. Claim 4 specifically disclaims methylene blue. Respectfully, the Blinka *et al.* '047 reference teaches a composition not covered by the claim, and does not suggest in any manner its use

on an optical recording medium. The reference cannot be said therefore in any manner to be anticipatory.

- Overall Comment on Examiner's 35 U.S.C. §102(b) Rejections

As indicated above, each of the references cited by the Examiner can not in any manner be said to anticipate the claims as amended, in fact a number of the references actually teach away from the claimed embodiments. Applicants therefore respectfully request that such rejections be withdrawn.

- REJECTION UNDER 35 U.S.C. §102(e)

- Examiner's Position

The Examiner has rejected claims 1 – 15, 21 - 24 under 35 U.S.C. §102(e) on the basis the claimed embodiments are obvious in light of certain art of record.

The Examiner asserts that claims 2 and 3 are fully anticipated by Brown *et al.* WO 02/096896.

The Examiner further asserts that claims 1 – 15 and 21 – 24 are fully anticipated by Vig *et al.* '088.

The Examiner further asserts that claims 4, 6 and 8 are fully anticipated by Cumpston *et al.* '228.

- Applicants' Response

Applicant respectfully traverses the rejection of claims 1 – 15, 21 – 24 under 35 U.S.C. §102(e) based in part on the argument that references either do not disclose each element of the embodiments being claimed, or are not appropriate prior art to this application. Applicant responds below to each rejection individually as structured by the Examiner.

- Claims 2 and 3 in Respect of the Brown *et al.* WO 02/096896 Reference (Paragraph 6 of the Office Action)

Applicants respectfully traverse the rejections of claims 2 and 3 with respect to the Brown *et al.* WO 02/096896 reference based in part on the argument that each element of the

claim embodiments is not found in the prior art of reference. However, as claims 2 and 3 are cancelled herein, such rejection is respectfully deemed moot.

- Claims 1 – 15 and 21 - 24 in Respect of the Vig *et al.* '088 Reference (Paragraph 16 of the Office Action)

Applicants respectfully traverse the rejections of claims 1 – 15 and 21 - 24 with respect to the Vig *et al.* '088 reference based in part on the argument that the reference is not properly citable against the present application.

Applicants note that the Vig *et al.* '088 is cited in the present application under the heading "Related Applications," that is, as U.S. Patent Application No. 10/641,784. The present application claims priority to U.S. Patent Application No. 10/641,784 as a continuation-in-part application. The different inventions asserted in the application relate to the subject matter that is being claimed in the claims as a whole. Applicants understand their obligation to determine the appropriate inventions upon final approval of a set of claims. Applicants respectfully assert that it is not appropriate for the Examiner to assert the asserted parent application as a 102(e) reference against the pending claims.

- Claims 4, 6, and 8 in Respect of the Cumpston *et al.* '228 Reference (Paragraph 20 of the Office Action)

Applicants respectfully traverse the rejections of claims 4, 6, and 8 with respect to the Cumpston *et al.* '228 reference based in part on the argument that each element of the claim embodiments is not found in the prior art of reference.

Applicants' remarks are now directed to amended claim 4 and depending claims 6 and 8. Applicant does not note in the Cumpston *et al.* reference any indication that the materials described in Example 9 should be applied to an optical recording medium. Further, Applicant notes that Example 9 recites the use of methylene blue which is specifically disclaimed within claim 4. As such the Cumpston *et al.* reference cannot be said to anticipate such claims in any manner.

- REJECTION UNDER 35 U.S.C. §103 (a)

- Examiner's Position

The Examiner has rejected all of the claims under 35 U.S.C. §103 on the basis the claimed embodiments are obvious in light of certain art of record.

The Examiner has specifically rejected claims 2 – 7 and 14 (paragraph 9 of the Office Action) as being obvious over Yamada *et al.* JP 63-187154 in view of Mellish *et al.* “In vitro photodynamic activity of a series of methylene blue analogues,” Photochem. Photobiol., Vol. 75(4) pp. 392 -397. The Examiner asserts that “[i]t would have been obvious to use other alkyl groups, such as propyl disclosed by Mellish *et al.* ... in place of the methyl groups of the methylene blue in the example of Yamada *et al.* 63-187154 with a reasonable expectation of success based upon the formula 2.”

The Examiner has further rejected claims 4, 6, 8-13 and 22 – 24 (paragraph 11 of the Office Action) as being obvious over Karasawa *et al.* JP 55-079441. The Examiner asserts that “[i]t would have been obvious to one skilled in the art to modify the cited example by using other disclosed amines, including the polymeric amines disclosed on page 3, with a reasonable expectation of forming a useful optical recording medium based upon the disclosure of equivalence.”

The Examiner has further rejected claims 2 – 14 and 22 – 24 (paragraph 12 of the Office Action) as being obvious over Karasawa *et al.* JP 55-079441 in view of Mellish *et al.* “In vitro photodynamic activity of a series of methylene blue analogues,” Photochem. Photobiol., Vol. 75 (4) pp. 392 – 397. The Examiner argues that “[i]n addition to the basis provided above, it would have been obvious to use other alkyl groups, such as propyl disclosed by Mellish *et al.* ... in place of the methyl groups of the methylene blue used in the example of Karasawa *et al.* JP 55-079441 with a reasonable expectation of success based upon the direction to thionine dyes within Karasawa *et al.* JP 55-079441 .

The Examiner has further rejected claims 1 – 3, 14 – 15, and 21 (paragraph 14 of the Office Action) as being obvious over Smith *et al.* ‘484, in view of Mellish *et al.* “In vitro photodynamic activity of a series of methylene blue analogues,” Photochem. Photobiol., Vol. 75 (4) pp. 392 – 397. The Examiner argues that Smith *et al.* ‘484 teaches “the use of various

phenothiazines including methylene blue and toluidine blue O in the copy prevention of optical recording media (cols. 11 and 12)” ... the substrate [being] provided with [a] reflective layer (156) and a copy protection layer (160)(9/14-44).” The Examiner urges that “[i]t would have been obvious to use other alkyl groups, such as propyl disclosed by Mellish ... in place of the methyl groups of the methylene blue used by Smith *et al.* ‘484 with a reasonable expectation of success.”

The Examiner has further rejected claims 1 – 3, 14 – 15 and 21 (paragraph 15 of the Office Action) as being obvious over Selinfreund *et al.* WO 02/03386 in view of Smith *et al.* ‘484 and Mellish *et al.* “In vitro photodynamic activity of a series of methylene blue analogues,” Photochem. Photobiol., Vol. 75 (4) pp. 392- 397. The Examiner reasons that Selinfreund *et al.* WO 02/03386 “teaches with respect to figure 8, the optical recording medium where the light sensitive materials which affects [sic] authentication being provided over the entire medium, on one surface of the medium or at predetermined areas” and that the “use of methylene blue with DVD media is disclosed,” as well as a medium with “authentication software.” The Examiner argues that “[i]t would have been obvious to one skilled in the art to modify the embodiment of figure 8 by placing the reactive layer adjacent the pits and reflective layer as taught by Smith *et al.* ‘484 with a reasonable expectation of providing the authentication desired based upon the disclosure to place the layer anywhere in the medium where it affects the laser beam as well as to use other alkyl groups, such as propyl disclosed by Mellish *et al.* ...in place of the methyl groups of methylene blue used by Smith *et al.* ‘484 and Selinfreund *et al.* WO 02/03386 with a reasonable expectation of success.”

The Examiner further rejects claims 1 – 3, 14 – 15 and 21 as being obvious over Selinfreund *et al.* ‘631 in view of Mellish *et al.* “In vitro photodynamic activity of a series of methylene blue analogues,” Photochem. Photobiol., Vol. 75 (4) pp. 392- 397 (paragraph 18 of the Office Action). The Examiner argues the Selinfreund *et al.* ‘631 “teaches in claims 36 – 52, the optical recording medium where the light sensitive materials which affects authentication being provided over the entire medium which is then coated with a reflective layer, ... authentication software ... [and the] use of methylene blue with DVD media.” The Examiner asserts that “[i]t would have been obvious to one skilled in the art to art [sic] to modify the embodiment of claims 36 – 52 by using other alkyl groups, such as propyl

disclosed by Mellish *et al.* ... in place of the methyl groups of methylene blue used by Selinfrend *et al.* '631 with a reasonable expectation of success.

And the Examiner yet further rejects all of the claims (claims 1 – 24) as being obvious over Vig *et al.* '088. The Examiner argues that “[i]t would have been obvious to one skilled in the art to modify the examples cited by using the media described with the authentication processes disclosed with a reasonable expectation of success based upon the disclosure to do so.”

- Applicants' Response

Applicants respectfully traverse the rejection of claims 1 – 24 based in part on the argument that the Examiner has provided inadequate, if any, motivation, for the references, and combination of references, which the Examiner asserts makes obvious the embodiments being claimed. Respectfully, Applicants assert that the multitude of disparate reference combinations raised by the Examiner, all of which are said to make “obvious to one skilled in the art to modify the examples” of the references “with a reasonable expectation of success,” clearly suggest impermissible hindsight reasoning in the obviousness rejections. Applicants further respectfully assert the Examiner combinations are at best an attempt to approximate a run through an “obvious to try” goal post, a post that has clearly been repudiated by the courts as an inappropriate standard for the determination of obviousness. Applicants now turn to each of the Examiner’s specific rejections in seriatim.

- Claims 2 – 7 and 14 as being obvious over the Yamada *et al.* JP 63-187154 Reference in view of the Mellish *et al.* Reference (paragraph 9 of the Office Action)

Combining two references that the Examiner has not shown in any manner to relate to the production of optical medium, one relating to the possible use of compounds as photosensitizers for the photodynamic therapy of cancer based on *in vitro* photodynamic activity of compounds (the Mellish reference), the other relating to the detection of the presence of oxygen by the change of hue (the Yamada reference), the Examiner asserts that one of ordinary skill in the optical disc arena searching to form a copy protected disc would be moved to combine such non-analogous art, choose among a number of chemical possibilities set forth in the references, and then apply the same to an optical disc according to the embodiments asserted in claims 2 – 7 and 14. Applicants totally disagree.

Looking for a thionine compound with propyl or hexyl side chains, the Examiner over and over again cites to the Mellish article to find obvious every claim being asserted. The Examiner points to a “reasonable expectation of success” upon replacement of the methyl groups of methylene blue of Yamada with other alkyl groups, such as propyl. He makes no mention of why either reference would provoke one to place methylene blue on an optical disc in the first place, especially in combination with an electron transfer agent as recited in amended claim 4, and even if they did would provoke one to apply another compound in the same thionine series from Mellish after finding that methylene blue did not provide the desired absorption characteristics. The Mellish reference simply does not suggest the use of the n-propyl analogue on an optical disc any more than it does the methyl (which Applicants found inadequate). Therefore, Applicants assert that claims 2 – 7 and 14 are not made obvious by such references.

- Claims 4, 6, 8-13 and 22 – 24 as being obvious over the Karasawa *et al.* JP 55-07944 Reference (paragraph 11 of the Office Action)

While the Examiner has not pointed out where in the Karasawa *et al.* reference it is mentioned to apply the thionine compounds of the reference to optical discs, the Examiner asserts that one of ordinary skill in the art would be motivated to do so upon reading this reference. The first problem with the reference is that its compounds do not conform to the structure recited in amended claim 4 (or claims 6, 8 – 13 that depend therefrom). Secondly, the Examiner provides no reasoning for asserting that any of the compounds of Karasawa *et al.* when applied into an optical disc polymeric coating would be activated at a wavelength of between about 630 nm to about 660 nm as recited in amended claim 22 (and depending claims 23 and 24). Again, applicants found an unexpected lambda shift (see, paragraph 00015 of the specification) that caused them to test a number of compounds without any appreciation of which would necessarily work or not. The embodiments asserted in such claims are simply not obvious.

- Claims 2 – 14 and 22 – 24 as being obvious over the Karasawa *et al.* JP 55-079441 Reference in view of the Mellish *et al.* Reference (paragraph 12 of the Office Action)

With respect to claims 2 and 3, Applicants note that such rejection is mooted in that the claims are cancelled herein.

In respect of amended claim 4, and claims 5 – 14 which depend thereon, Applicants first note that one would have to reject the teaching of Karasawa *et al.* with respect to which thionine compounds to utilize (as claim 4 does not cover such compounds) before reaching the first base in the Examiner's analysis. The Examiner provides no reason for such rejection. Then one would have to combine the disparate references of Karasawa related to recording material with the Mellish reference related to uncovering compounds for use in *in vivo* photodynamic therapy. The Examiner once more provides no reason for doing so. Then one would have to disregard certain compounds discussed in Mellish (such as methylene blue) and select a compound within the chemical structure of claim 4. Again the Examiner has provided no reason why one of ordinary skill in the art would do so. Then one would have to place such a compound of the Mellish *et al.* reference in a location and in a quantity specified in amended claim 4 onto an optical disc (as opposed to any other recording medium). Again the Examiner provides no reason for doing the same. In short, the references simply do not make obvious the claim 4 and its dependent claims.

In respect of claim 22, once more there is nothing in either of the two references to suggest that any of the compounds would provide the desired optical activation at the wavelengths specified when placed into a polymeric optical coating. Other than citing that there would be a "reasonable expectation" that the same would work, the Examiner has provided no evidence that one would actually be able to predict *a priori* that certain compounds would work, and others would not.

- Claims 1 – 3, 14 – 15, and 21 as being obvious over the Smith *et al.* '484 Reference, in view of the Mellish *et al.* Reference (paragraph 14 of the Office Action)

With respect to claims 2 and 3, Applicants note that such rejection is mooted in that the claims are cancelled herein.

In this rejection, the Examiner moves to a reference related to a copy protectable optical disc (Smith *et al.* '484) to combine with the Mellish reference (which discusses the propyl and hexyl thionine analogues) to find obviousness once more. The problem with the Examiner's selection of references is that the Smith *et al.* reference seeks to hide data from purview after a period of time, that is to limit access to data stored in an optical medium. Thus one would be motivated by such reference to seek compounds that after time hide data

(e.g., limited use demo discs), not which have application in the copy protection schemes discussed in the present application. It is unclear why one would be motivated to select a compound from those in Mellish instead of the compounds discussed in Smith *et al.* The Examiner once again provides no answer – just that there is a “reasonable expectation” that one would. In regard to claim 1 and 21, the Examiner does not suggest in any manner why the references would even remotely suggest applying [7-(dipropylamino)phenothiazin-3-ylidene]dipropylamine to the disc, or that such a compound when placed on the disc would be detectable by an optical reader producing a wavelength of about 630 nm to about 660 nm (as set forth in claim 14, and claim 15 which depends therefrom) without any undue experimentation being required.

- Claims 1 – 3, 14 – 15 and 21 as being obvious over Selinfreund *et al.* WO 02/03386 Reference in view of the Smith *et al.* ‘484 Reference and the Mellish *et al.* Reference (paragraph 15 of the Office Action)

With respect to claims 2 and 3, Applicants note that such rejection is mooted in that the claims are cancelled herein.

Possibly recognizing the inadequacy of the rejection given above, the Examiner adds Selinfreund *et al.* WO 02/03386 to his litany of references to find the same claims unpatentable. The problem again is that the Smith *et al.* reference seeks a disparate type of copy protection than disclosed in Selinfreund *et al.* WO 02/03386. Smith *et al.* generally desires to limit use of readable data after a period of time, while the Selinfreund *et al.* reference generally seeks to allow data to be read only if one is authorized to read it. It is unclear how the addition of the Selinfreund *et al.* WO 02/03386 adds to the Examiner’s argument. Again in regard to claim 1 and 21, the Examiner does not suggest in any manner why the references would even remotely suggest applying [7-(dipropylamino)phenothiazin-3-ylidene]dipropylamine to the disc, or that such a compound when placed on the disc would be detectable by an optical reader producing a wavelength of about 630 nm to about 660 nm (as set forth in claim 14, and claim 15 which depends therefrom) without any undue experimentation being required.

- Claims 1 – 3, 14 – 15 and 21 as being obvious over the Selinfreund *et al.* ‘631 Reference in view of the Mellish *et al.* Reference (paragraph 18 of the Office Action)

Possibly recognizing the problem with the Smith *et al.* reference, in this rejection the Examiner drops Smith *et al.* entirely and seeks to reject the same claims (claims 1 – 3, 14 – 15 and 21) on the basis of Selinfreund *et al.* ‘631 and the Mellish *et al.* reference alone.

Once more, with respect to claims 2 and 3, Applicants note that such rejection is mooted in that the claims are cancelled herein.

While the Selinfreund *et al.* ‘631 reference might have one looking for compounds useful in the type of copy protection described in the present application, it remains unclear why one would consult an article seeking new photodynamic therapy agents for compounds that might be useful in copy protection schemes when placed onto an optical disc. When applied it still remains unclear that the same absorption characteristics would be evinced as if the material was dispersed or solvated in an aqueous solutions as set forth in Table 1 of the Mellish *et al.* reference. Recitation of a “reasonable expectation” of success without more (specifically in light of the numerous factors that may change the absorption spectrum of a compound) is simply not enough for an assertion of obviousness. Claims 1, 14 – 15 and 21 are simply not made obvious by these references alone or in combination with Smith *et al.* ‘484.

- Claims 1 – 24 in Respect of the Vig *et al.* ‘008 Reference (Paragraph 16 of the Office Action)

In an omnibus rejection, the Examiner rejects all of the claims as being obvious in light of the Vig *et al.* ‘008. The problem with such rejection, as noted above, is that the Vig *et al.* ‘008 application is cited as a parent of the present application (that is under the “Related Applications” section of the specification this application is stated to be a CIP of U.S. Patent Application No. 10/641,784, *viz.* Vig *et al.* ‘008). Thus it is asserted that this reference is not appropriately citable as prior art for either anticipation or obviousness.

- Rejection under Judicially Created Doctrine of Obviousness-type Double Patenting

- Examiner's Position

The Examiner has rejected all of the claims, claims 1- 24, provisionally under the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 1 – 17 of copending Application No. 10/641,784 (US 2004/0110088). The Examiner argues that the “subject matters overlaps [sic] and it would hgave [sic] been obvious to use the propylene blue compounds based upon the direction in claims 8 to the substuents [sic] being propyl or hexyl.”

- Applicants' Response

Applicants respectfully request that the Examiner hold this provisional rejection in abeyance until patentable claims are to be issued in this or copending application No. 10/641,784. Applicant if necessary will file an appropriate terminal disclaimer.

- Prior Art Made of Record but Not Relied Upon

- Examiner's Position

The Examiner has cited Selinfreund '626, '593 and '124 as art of record but not relied upon these references.

- Applicants' Response

Applicants have reviewed the art, and respectfully assert that it does not predict the claimed inventions and that no further comment is deemed necessary at this time.

CONCLUSION TO REMARKS

Applicants assert that this response is fully responsive to the Examiner's Office action dated June 14, 2005. Applicants respectfully seek early allowance of the pending claims.

Respectfully Submitted,



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VI. APPENDIX

- *Appendix of Pages Demonstrating Acronym Meaning – 9 Pages*